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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/620,656	07/15/2003	Alan Treibitz	415.002US3	1463

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EXAMINER

LONG, ANDREA NATAE

ART UNIT PAPER NUMBER

2176

DATE MAILED: 10/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/620,656	Applicant(s) TREIBITZ ET AL.	
	Examiner Andrea N. Long	Art Unit 2176	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152..

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>07/15/2003</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-16 have been examined with a priority date of December 23, 2002.

The claims in the present application are broader in scope than those in US Patent # 6,091,408 and are rejected as set forth below.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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3. Claim 1 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,091,408. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following reasons:

Claim 1 of US Patent 6,091,408	Claim 1 of instant application 10/620,656
a method of presenting a set of information units comprising the steps of:	a method of presenting a set of information units comprising the steps of:
A) providing a first presentation unit positioned to be viewed by a person controlling the presentation of information units on a second presentation unit,	A) providing a first presentation unit positioned to be viewed by a person controlling the presentation of information units on a second presentation unit,
B) positioning the second presentation unit to be viewed by an audience	B) positioning the second presentation unit to be viewed by an audience
C) presenting on the first presentation unit a first information unit from the set which a candidate to be presented on the second presentation unit and if desired selecting it to be presented on the second presentation unit;	C) presenting on the first presentation unit a first information unit from the set which a candidate to be presented on the second presentation unit and if desired selecting it to be presented on the second presentation unit;
D) presenting the first information unit on the second presentation unit if it is selected for presentation	D) presenting the first information unit on the second presentation unit if it is selected for presentation
E) while presenting the first information unit on the second presentation unit, presenting on the first presentation unit a second information unit from the set which is a candidate to be presented on the second presentation unit and if desired selecting it to be presented on the second presentation unit;	E) while presenting the first information unit on the second presentation unit, presenting on the first presentation unit a second information unit from the set which is a candidate to be presented on the second presentation unit and if desired selecting it to be presented on the second presentation unit;
F) presenting the second information unit on the second presentation unit if it is selected for presentation, wherein the first information unit is replaced by the second information unit;	F) presenting the second information unit on the second presentation unit if it is selected for presentation, wherein the first information unit is replaced by the second information unit;
G) controlling the presentation of	G) controlling the presentation of

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information units on the first and second presentation units using one or more computers	information units on the first and second presentation units using one or more computers
H) grouping information units into sets, and displaying on the first presentation unit a list of names of the information units that can be accesses and displayed; and	
I) selectively displaying only those names of sets that are desired for access during a given time period so that the names of sets that are not desired for access during the given time period are hidden from view.	

Note the comparison above, claim 1 of the instant application 10/620,656 is not patentably distinct from claim 1 of US Patent 6,091,408 because Claim 1 of the instant application is broader than claim 1 of US Patent 6,091,408. For example, claim 1 of the instant application 10/620,656 does not include the limitations of "grouping information units into sets, and displaying on the first presentation unit a list of names of the information units that can be accesses and displayed" and "selectively displaying only those names of sets that are desired for access during a given time period so that the names of sets that are not desired for access during the given time period are hidden from view" as recited in claim 1 of US Patent 6,091,408. It would have been obvious to have to remove those limitations where those functionalities are not needed.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-2, 5-8, and 16 are rejected under 35 U.S.C. 102(e) as being anticipated by Howell et al. (US Patent 5767897) hereinafter "Howell".

As for claims 1 and 16,

Howell discloses *a method of presenting and displaying a set of information units comprising the steps of:*

providing a first presentation unit positioned to be viewed by a person
controlling the presentation of information units on a second presentation
unit (Fig. 1, column 1 line 25 to column 2 line 10, column 7 line 40 to column 16 line 20
→ Howell discloses a video conferencing system, wherein a presenter previews the information on one display that will be provided to an audience on a second display),

positioning the second presentation unit to be viewed by an audience (Fig. 1→
Howell pictorially discloses a second display for viewing by an audience) ;

presenting on the first presentation unit a first information unit from the set which is a candidate to be presented on the second presentation unit and if desired selecting it to be presented on the second presentation unit (column 1 line 25 to column 2 line 10 → Howell discloses the presenter previewing the information to be displayed on the display that will be presented to the audience, upon the presenter touching a switch the presenter's information will be transferred to the audience's display screen);

presenting the first information unit on the second presentation unit if it is selected for presentation (column 1 line 25 to column 2 line 10, column 7 line 40 to column 16 line 20 → Howell discloses upon the presenter touching a switch the presenter's information will be transferred to the audience's display screen);

while presenting the first information unit on the second presentation unit, presenting on the first presentation unit a second information unit from the set which is a candidate to be presented on the second presentation unit and if desired selecting it to be presented on the second presentation unit (column 1 line 25 to column 2 line 10, column 7 line 40 to column 16 line 20 → Howell discloses while information is being displayed to the audience, the presenter can preview a new set of information before presenting that information to the audience);

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presenting the second information unit on the second presentation unit if it is selected for presentation, wherein the first information unit is replaced by the second information unit (column 1 line 25 to column 2 line 10, column 7 line 40 to column 16 line 20 → Howell discloses when a presenter touches a switch the information that is being viewed by him/her will replace the information that is currently being viewed by the audience); and

controlling the presentation of information units on the first and second presentation units using one or more computers (column 3 lines 5-30, Figs. 1-2 → Howell discloses that a computer is included in the control section of the video conferencing system).

Howell discusses a main screen mode where the presenter's screen displays a preview area and a presentation area (Fig. 2, columns 7-16). The presenter may control many units of information to be displayed on the audience's display (column 5 line 60 to column 6 line 40).

As to claim 2,

Howell discloses wherein there is provided one or more additional presentation units and including the step of controlling the presentation of a candidate information unit so that it can be selectively presented on any combination of the second presentation unit or the additional presentation units (Fig. 1 column 3 line 5-30 →

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Howell discloses that the presenter's information can be displayed on a plurality of remote sites).

As to claim 5,

Howell discloses *enhancing an information unit displayed on the first presentation unit while the same information unit is displayed on the second presentation unit and providing that the enhancements are viewed on both the first and second presentation units* (Fig 4, columns 16-17 → Howell discloses the presenter being able to edit the information being displayed to the audience).

As to claim 6,

Howell discloses *displaying the same selected information unit on both the first and second presentation units at the same time* (Figs 2-3, column 5 line 60 to column 6 line 40 → Howell discloses that the presentation information can be displayed to the presenter and audience simultaneously).

As to claim 7,

Howell discloses *displaying on the first presentation unit a list of information unit names corresponding to information units in the set, selecting one of the information unit names, and displaying as the first information unit an information unit corresponding to the information unit name selected* (column 15 lines 45-65 → Howell discloses showing a selectable list of files).

As to claim 8,

Howell discloses *displaying a list of names of information units that have been selected for display* (column 15 lines 45-65 → Howell discloses showing a selectable list of files for display).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 3-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Howell in view of Allen et al. (US Patent 5473744) hereinafter "Allen".

As to claim 3 and 4,

Howell does not explicitly teach a courtroom location and a jury audience, but Allen does teach a courtroom setting (Fig. 1, column 2 line 50 to column 3 line 25 → Allen teaches a courtroom setting, with counsel as the presenter and the judge and jury as the audience, which all have presentation units to view).

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It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the presentation method of Howell to the courtroom setting of Allen in order to enhance the effective presentation of information or evidence .

8. Claims 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Howell in view of Ludwig et al. (US Patent 5758079) hereinafter "Ludwig".

As to claim 9,

Howell does not explicitly teach *additional control presentation unit and selecting the information units to be displayed either by reference to the first presentation unit or by reference to the additional control presentation unit*. However, Ludwig does teach *additional control presentation unit and selecting the information units to be displayed either by reference to the first presentation unit or by reference to the additional control presentation unit* (column 26 line 20 to column 27 line 28 → Ludwig teaches participants may control an information unit).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have used the teaching from Ludwig of allowing additional control units and sending text messages in Howell's method in order for participants to better share information among users.

As to claim 10,

Howell does not explicitly teach *providing a separate computer and sending a first text message from the location of the separate computer and displaying the message on the first presentation unit*. However, Ludwig does teach *providing a separate computer and sending a first text message from the location of the separate computer and displaying the message on the first presentation unit* (column 26 line 20 to column 27 line 68 → Ludwig teaches sending annotations including text messages to snapshots).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have used the teaching from Ludwig of allowing additional control units and sending text messages in Howell's method in order for participants to better share information among users.

As to claim 11,

Howell does not explicitly teach *sending a second text message from location of the first presentation unit in response to the first text message and displaying the second text message on the separate computer*. Ludwig does teach *sending a second text message from location of the first presentation unit in response to the first text message and displaying the second text message on the separate computer* (column 26 line 20 to column 27 line 68 → Ludwig teaches sending annotations including text messages to snapshots).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have used the teaching from Ludwig of allowing additional control units and sending text messages in Howell's method in order for participants to better share information among users.

9. Claims 12 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Howell et al. (US Patent 5767897) in view of Allen et al. (US Patent 5473744) as applied to claims above, and further in view of Ludwig et al. (US Patent 5758079).

As to claim 12,

Howell does not explicitly teach a courtroom setting and a jury audience, but Allen does teach a courtroom setting (Fig.1, column 2 line 50 to column 3 line 25). It would have been obvious to one skilled in the art at the time the invention was made to display information to a jury and judge in a courtroom in order to enhance the effectiveness of information or evidence.

Moreover, Allen does not explicitly teach *introducing information units into the network for display on one of the presentation units wherein the introduced information units are stored in a location outside of the courtroom*. However, Ludwig does teach *introducing information units into the network for display on one of the presentation units wherein the introduced information units are stored in a location outside of the*

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courtroom (column 8 line 50 to column 9 line 33, column 30 line 15 to column 31 line 50
→ Ludwig discloses storing information on a network for display different from a location
of the workstation).

It would have been obvious to one of ordinary skill in the art at the time the
invention was made to store information outside a courtroom in order to reduce bulky or
expensive hardware in a public location.

As to claim 13,

Ludwig teaches participants may control an information unit (column 26 line 20 to
column 27 line 68).

It would have been obvious to one of ordinary skill in the art at the time the
invention was made to have used the teaching from Ludwig of allowing additional
control units and sending text messages in Howell's method in order for participants to
better share information among users.

10. Claims 14 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable
over Howell as applied to claims above, and further in view of Wolters, Jr. et al. (US
Patent 5826252) hereinafter "Wolters".

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As for claim 14 and 15,

Howell teaches a list of names (column 15 lines 45-65, but does not explicitly teach *grouping the information units into sets*. However, Wolters *grouping information into sets* (column 4 lines 35-49 → Wolters discloses files may be stored in directories).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the teaching from Wolters' of grouping information into sets in Howell's method in order to more effectively organize stored information.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Tsakiris (US Patent 5736968) "Computer controlled presentation system", Tafoya et al. (US Patent 5822525) "Method and system for presentation conferencing", Saito et al. (US Patent 4876657) "Presentation display apparatus for displaying two different images on separate displays for a listener and a speaker".

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrea N. Long whose telephone number is 571-270-1055. The examiner can normally be reached on Mon - Thurs 7:30 am to 5:00 pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon can be reached on 571-272-4136. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Andrea N. Long
10/16/2006


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